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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,685	05/03/2001	Jens Hamann	A34189 (071308.0149)	7455

7590

07/05/2002

BAKER BOTTS L.L.P.
44TH FLOOR
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112-4498

EXAMINER

MACKEY, JAMES P

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 07/05/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

HCT

Office Action Summary

Application No.

09/848,685

Applicant(s)

HAMANN

Examiner

James Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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1. Claims 4-7 and 10-11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 4, 5, 7, 10 and 11 merely recite how the claimed structure is intended to be operated during the intended use of the apparatus; however, such relates only to the intended use of the claimed apparatus structure, which does not patentably distinguish apparatus structure and therefore does not further limit the subject matter of the apparatus claims. Note that intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re Finsterwalder*, 168 USPQ 530. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235.

Claim 6 merely recites how the claimed structure was designed; however, such relates only to the process of making the claimed apparatus, which does not patentably distinguish apparatus structure and therefore does not further limit the subject matter of the apparatus claims.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-4, 6 and 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claims 2, 3, 4 and 9, "between clamping platen and closing platen" should be --between said clamping platen and said closing platen-- for clarity.

In claim 4, "actuated differently" is unclear and indefinite as to exactly how this defines the structure intended to be claimed.

In claim 6, "is derived from the closing force" is unclear and indefinite as to exactly how this defines the structure intended to be claimed; and "the platen" is indefinite as to which of the plural platens is being referred to.

In claims 10 and 11, the use of "can be" does not positively set forth claimed subject matter.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Document 10-12649.

Japan '649 teaches stationary platen 6 (note that either platen 5 or 6 can be movable toward the other), closing platen 7, and clamping platen 5 movable together with closing platen 7 as a unit, with a matrix of piezoelectric elements 1 being distributed in the area between the clamping platen and the closing platen, the piezoelectric elements being selectively actuated (in response to pressure detected by sensors 4) for providing a clamping force to the mold. Note that

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a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Document 10-12649.

Japan '649 teaches stationary platen 6 (note that either platen 5 or 6 can be movable toward the other), closing platen 7, and clamping platen 5 movable together with closing platen 7 as a unit, with a matrix of piezoelectric elements 1 being distributed in the area between the clamping platen and the closing platen, the piezoelectric elements being selectively actuated (in response to pressure detected by sensors 4) for providing a clamping force to the mold. Japan '649 does not disclose the pressure sensors as being located between the closing platen and the clamping platen, and does not apparently disclose the pressure sensors as being piezoelectric sensors. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Japan '649 by providing the pressure sensors 4 between the closing platen and the clamping platen, rather than on the opposite side of the stationary carrier platen, since

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such involves the mere shifting of the location of parts without affecting the functioning of the apparatus structure, which has been held to be within the general level of skill in the art (it has generally been recognized that to shift location of parts when the operation of the device is not otherwise changed is within the level of ordinary skill in the art, *In re Japikse*, 86 USPQ 70; *In re Gazda*, 104 USPQ 400). Moreover, the use of piezoelectric elements as pressure sensors is conventional in the art, and it would have been obvious to a skilled artisan to have utilized conventional piezoelectric pressure sensors since such were equivalent to the pressure sensors taught in Japan '649.

8. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent Document 43 36 572 in view of either Japanese Patent Document 10-12649 or Takagi et al. (U.S. Patent 5,269,998).

German '572 discloses the apparatus substantially as claimed, except for the means to provide the clamping force being piezoelectric elements. Each of Japan '649 and Takagi et al. disclose a molding apparatus wherein piezoelectric elements are utilized to provide a clamping force. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify German '572 by providing the clamping force applying means as piezoelectric elements, as disclosed in either Japan '649 or Takagi et al., since such were equivalent to the clamping force applying means disclosed in German '572. Note that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus

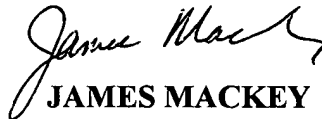
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from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is (703) 308-1195. The examiner can normally be reached on Monday-Friday from 8:30AM to 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jan Silbaugh, can be reached at (703) 308-3829. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651. Any inquiry relating to the contents or papers filed in this application, other than issues of substance requiring the attention of the Examiner, should be directed to the Customer Service Office, Technology Center 1700, whose telephone number is (703) 306-5665.

MACKEY/jpm
July 1, 2002


JAMES MACKEY
PRIMARY EXAMINER
ART UNIT 1722

7/1/02